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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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James Mathew Hodgson

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EXAMINER

LALLI, MELISSA LYNN

ART UNIT

PAPER NUMBER

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/562,963	<b>Applicant(s)</b> HODGSON, JAMES MATHEW	
	<b>Examiner</b> MELISSA L. LALLI	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 25-29,34-40,42 and 48-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-29,34-40,42 and 48-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/29/10</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is in response to applicant's amendment wherein claims 25, 27, 34, 36, and 37 have been amended, claims 48-52 have been added, and claim 41 has been canceled. Therefore, claims 25-29, 34-40, 42, and 48-52 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Drawings***

3. The drawings are objected to because the photocopies submitted are poor and have too many dots and lines which render the drawings unclear. Also, certain reference numbers and drawing lines are not clear as the printing is faded. The reference numbers and drawings must be distinct and dark as well as the lines and dots must be removed and clean, formal copies of each of Figs. 1-7 must be submitted. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application

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must be labeled in the top Margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. Claims 34-40, 42, and 49-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 34 and 37, the limitation "at least one opening that extends through an entire thickness of the instep side supports" is vague and indefinite. What is the "at least one opening" applicant refers in the claim? Is it the two symmetrical openings formed at the heel part between the two heel side supports and the end heel support? If so, it is unclear if that area would be considered the "instep side supports". Or is applicant referring to the opening (95) in the instep-heel part which extends from the flat area of the sole to one of the "instep side supports"? It is unclear what structure is encompassed by such language. Applicant is required to clarify and amend the claims as necessary.

Claims 35 and 36 recite the limitation "the other end" in line 4 and lines 10-11 respectively. There is insufficient antecedent basis for this limitation in the claim. The limitation "the other end" should be replaced with "a second end opposite the first end" or something similar to correct this issue.

Regarding claims 51 and 52, the limitation “the at least one opening defines a majority of the instep side supports” as stated on lines 1-2 of each claim is vague and indefinite. What is meant by “a majority of the instep side supports”? There does not appear to be any opening defining a majority of the instep side supports as is stated. Applicant is required to clarify and amend the claims as necessary.

***Claim Rejections - 35 USC § 102***

5. Claims 34, 49, and 51 (as best understood) are finally rejected under 35 U.S.C. 102(b) as being anticipated by US 3,605,292 to Goldblatt.

Regarding claim 34, Goldblatt discloses an article of footwear (figs. 4 & 7) comprising: a sole (20) having a toe part (fig. 7, see unlabeled toe part), a ball part (fig. 7, at 14), an instep part (fig. 7, see unlabeled instep part), and a heel part (fig. 7, near 32), wherein the heel part includes at least one cut-out (22) that extends through an entire thickness of the heel part so that at least a portion of a wearer's foot is exposed through the cut-out when the wearer's foot is inserted into the article of footwear (fig. 7); an open toe section (fig. 7); an instep section (fig. 7, see unlabeled instep section) having two instep side supports (fig. 7, see unlabeled instep side support and not shown opposite instep side support), the instep side supports being connected to the instep part of the sole and defining at least one opening (18) that extends through an entire thickness of the instep side supports (fig. 7); and a heel section (fig. 7, at 32).

Regarding claims 49 and 51, Goldblatt discloses the toe part (fig. 7, see unlabeled toe part) being curved in a direction extending away from a ground-contact surface of the sole (20) in each of a medial side, a lateral side, and a distal side of the

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toe part (fig. 7). The at least one opening (20) defines a majority of the instep side supports (fig. 7).

***Claim Rejections - 35 USC § 103***

6. Claim 25 and 48 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,177,582 to Ehrlich, Jr. (Ehrlich) in view of US 3,640,006 to Kendrick.

Regarding claim 25, Ehrlich discloses a sole (fig. 2) for footwear comprising: a toe part (1) made of a substantially inflexible material; a ball part (3) being made of a flexible material, and an instep-heel part (2) being made of a substantially inflexible material (see lines 1-4 of the abstract). Ehrlich does not disclose the instep-heel part including at least one cut-out that extends through an entire thickness of the instep-heel part so that at least a portion of a wearer's foot is exposed through the cut-out when the wearer's foot is inserted into the footwear; however, Kendrick discloses a sole (11) for footwear comprising an instep-heel part (figs. 1 & 2, at 11) including at least one cut-out (12) that extends through an entire thickness of the instep-heel part so that at least a portion of a wearer's foot (14) is exposed through the cut-out when the wearer's foot is inserted into the footwear (fig. 1). It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated the at least one cut-out of Kendrick in the instep-heel part of the sole of Ehrlich in order to provide air circulation to the wearer's foot and to reduce the overall weight of the footwear for comfort of the wearer as taught by Kendrick (col. 1, lines 34-36).

Regarding claim 48, Ehrlich discloses the toe part being curved in a direction extending away from a ground-contact surface of the sole in each of a medial side, a lateral side, and a distal side of the toe part (fig. 7, 10).

7. Claims 25 and 29 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1,234,516 to Oorei in view of Kendrick.

Regarding claim 25, Oorei discloses a sole (1) for footwear comprising: a toe part (C) made of a substantially inflexible material; a ball part (F) being made of a flexible material, and an instep-heel part (A, B, & D) being made of a substantially inflexible material (paragraph [0034]). Oorei does not disclose the instep-heel part including at least one cut-out that extends through an entire thickness of the instep-heel part so that at least a portion of a wearer's foot is exposed through the cut-out when the wearer's foot is inserted into the footwear; however, Kendrick discloses a sole (11) for footwear comprising an instep-heel part (figs. 1 & 2, at 11) including at least one cut-out (12) that extends through an entire thickness of the instep-heel part so that at least a portion of a wearer's foot (14) is exposed through the cut-out when the wearer's foot is inserted into the footwear (fig. 1). It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated the at least one cut-out of Kendrick in the instep-heel part of the sole of Oorei in order to provide air circulation to the wearer's foot and to reduce the overall weight of the footwear for comfort of the wearer as taught by Kendrick (col. 1, lines 34-36).

Regarding claim 29, Oorei discloses a plurality of spikes being attached to the toe part (41-44 and paragraph [0037]).

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8. Claims 26 and 27 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over each of Ehrlich/Kendrick and Oorei/Kendrick as applied to claim 25 above, and further in view of US 5,752,332 to Kataoka et al. (Kataoka).

Regarding claims 26 and 27, Ehrlich/Kendrick does not disclose the toe and instep-heel parts being formed of a composite material of carbon fiber in a thermoplastic resin and Oorei/Kendrick discloses the use of carbon fiber as reinforcement in the rigid material (Oorei; paragraph [0034]) but does not specify thermoplastic resin being used as a base material; however, Kataoka discloses a sole (fig. 1) for footwear comprising a toe part and an instep-heel part being formed of a substantially inflexible material. The substantially inflexible material may be formed from a composite material of carbon fiber in a thermoplastic resin (col. 4, lines 14-18). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the composite material of Kataoka for the inflexible portions of the sole of either footwear of Ehrlich/Kendrick or Oorei/Kendrick in order to form robust and rigid structures as taught by Kataoka and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

9. Claim 28 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over each of Ehrlich/Kendrick/Kataoka and Oorei/Kendrick/Kataoka as applied to claims 26 and 27 above, and further in view of US 6,854,200 to Hipp et al. (Hipp).

Regarding claim 28, neither Ehrlich/Kendrick/Kataoka nor Oorei/Kendrick/Kataoka discloses the ball part being formed of a composite material of

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aramid fiber in a thermoplastic resin; however, Hipp discloses a footwear (51) with a section (12) being formed of flexible material which is a composite material of aramid fiber and thermoplastic resin (col. 5, lines 34-53). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the composite material of Hipp for the flexible portion of the sole of either footwear of Ehrlich/Kendrick/Kataoka or Oorei/Kendrick/Kataoka in order to form a strong yet resiliently flexible structure as taught by Hipp and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

10. Claims 35-40, 42, 50, and 52 (as best understood) are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Goldblatt in view of US 6,122,845 to Menghi.

Regarding claim 35, it is unclear whether Goldblatt discloses the heel section comprising two heel side supports and an end heel support, wherein the two heel side supports and the end heel support are connected at a first end to the heel part of the sole and are connected to each other at a second end opposite the first end; however, Menghi discloses a similar article of footwear (figs. 1 & 2) comprising a sole (1) having a toe part, a ball part, an instep part, and a heel part (see figs. 1 & 2 generally). The article of footwear also comprises an instep section (fig. 2, see unlabeled instep section) and a heel section (fig. 1, at 2) wherein the heel section has two heel side supports (fig. 2, see unlabeled diagonal heel side support having two circular openings F and opposite unlabeled heel side support shown in fig. 1) and an end heel support (fig. 2, at 2), wherein the two heel side supports and the end heel support are connected at a first

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end to the heel part of the sole and are connected to each other at a second end opposite the first end (figs. 1 & 2). It would have been obvious to one having ordinary skill in the art at the time of the invention to have formed the heel section of the article of footwear of Goldblatt in the configuration having two heel side supports and an end heel support disclosed by Menghi, if Goldblatt is not already doing so, in order to ensure foot transpiration while preventing penetration of pebbles or other objects inside the article of footwear during use as taught by Menghi (col. 2, lines 16-19).

Regarding claims 36 and 37, Goldblatt and Menghi disclose all of the claimed structures as is discussed in detail in the rejections of claims 34 and 35 above.

Regarding claims 38 and 42, Goldblatt discloses the article of footwear further comprising an upper instep section (fig. 7, at 12) and being an athletic shoe (fig. 7).

Regarding claim 39, Menghi discloses an upper instep section (3) being attached to instep side supports by means of adjustable ties (5, 6, & 7-7b).

Regarding claim 40, Goldblatt discloses a plurality of spike-like traction elements (23) mounted on an underside of the toe part of the sole. It is unclear if the structures disclosed by Goldblatt meet the definition of a "spike"; however, the traction elements disclosed by Goldblatt are equivalent to the structure disclosed by applicant. Both structures encompass the identical function of adding traction to the surface of the sole of a footwear; hence, it would have been obvious to one having ordinary skill in the art at the time of the invention to have substituted spikes for the traction elements of the article of footwear of Goldblatt and Menghi since it is old and conventional in the art to incorporate spikes on the sole of a footwear and as a matter of obvious design choice

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and intended use. The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Regarding claims 50 and 52, Goldblatt discloses all of the claimed structures as is discussed in detail in the rejections of claims 49 and 51 above.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 25-29, 34-40, 42, and 48-52 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bente, Bernardoni, Oorei et al. ('424), Zamprogno, and Mochizuki have been included because they are relevant to the claimed subject matter.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA L. LALLI whose telephone number is (571)270-5056. The examiner can normally be reached on Monday-Friday 7:30 AM-5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLL  
5/08/10

/Mickey Yu/  
Supervisory Patent Examiner, Art  
Unit 3728